

REMARKS

At the outset, Applicants wish to thank the Examiner for the thorough review and consideration of the subject application. The Non-Final Office Action of March 26, 2003, has been received and its contents carefully noted. By this amendment, claims 1-14 have been cancelled without prejudice or disclaimer to the subject matter therein and claims 15-34 have been added to better cover the present invention. Accordingly, claims 15-34 are currently pending in the application, of which claim 15 is independent.

In the Office Action claims 1-5 and 13-14 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 11-15 of co-pending Application No. 09/902,828; claims 1-14 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 3,309,437 issued to Harnett in view of U.S. Patent No. 4,127,391 issued to Koppelman combined with Great Brittan Patent No. 1,480,690 issued to Madley et al. ("Madley"), Encyclopedia of Chemical Technology authored by Kirk-Othmer and JP Patent No. 8-112876 Patent-Assignee Kuroda. Applicants respectfully traverse these rejections and reconsideration is hereby requested.

Provisional Obviousness Type Double Patenting

The Examiner provisionally rejected claims 1-5 and 13-14 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 11-15 of co-pending Application No. 09/902,828. Applicants respectfully submit the provisional rejection is moot in view of claim 12 being cancelled.

Rejections Under 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 3,309,437 issued to Harnett in view of U.S. Patent No. 4,127,391 issued to Koppelman combined with Great Brittan Patent No. 1,480,690 issued to Madley et al. ("Madley"), Encyclopedia of Chemical Technology authored by Kirk-Othmer and JP Patent No. 8-112876 Patent-Assignee Kuroda. Applicants respectfully submit this rejection is moot in view of claims being cancelled. In order to expedite prosecution Applicants submit the following remarks to distinguish the present invention of the cited references.

Claim 15 is allowable over the cited references in that claim 15 recites a combination of elements including, for example, "a matrix of coal-based cells reinforced with at least one layer of a fibrous carbonaceous material, wherein said coal-based cellular product includes a carbon foam having a first and second density." None of the cited references either singly or in combination teaches or suggests at least these features.

The Examiner suggests that the claims require that the core be laminated with a sheet product. (Office Action at 5). This is not the case. The claims require that the coal-based cellular product is reinforced with at least one layer of a fibrous carbonaceous material. For example, the material can be on the surface of the product or contained within the body of the product. The claim is not limited to the material being on the surface of the product.

The Examiner admits that Harnett, Koppelman, Madley and Kirk-Othmer fail to disclose a core with laminated sheets. This combination, even if proper, would fail to disclose a layer of fibrous carbonaceous material as required by claim 15. To supply this missing limitation, the Examiner relies on Kuroda.

The Examiner alleges "it would be obvious to the artisan in the art to use a core between laminate sheets." (Office Action at 5). Additionally, the Examiner alleges Kuroda teaches "laminated sheets comprising a core of charcoal powder (graphitized coal product) and activated carbon powder (carbonized and coal product) note the English abstract and Figures 1-3. (Office Action at 5). Kuroda abstract discloses:

[A] laminated sheet obt'd. by laminating steam- and air-permeable nonwoven fabric clothes, with a layer composed of at least one of charcoal powder and activated carbon powder having such a particle dia. not to permeate the clothes sandwiched in.

See Abstract of Kuroda.

Based on the abstract of Kuroda, there is nothing to indicate that the charcoal powder and activated carbon powder of Kuroda is a coal product as suggested by the Examiner. Further there is nothing in the abstract of Kuroda that discloses carbon foam or coal-based cells as required by Applicant's claim 15. Applicants respectfully request a translation of Kuroda in order to fully interpret the contents of the rejection. Applicants, respectfully submit that Kuroda fails to cure the deficiencies of Harnett, Koppelman, Madley, and Kirk-Othmer as none of the cited references either singly or in combination teaches or suggests, "a matrix of coal-based cells reinforced with at least one layer of a fibrous carbonaceous material, wherein said coal-based cellular product includes a carbon foam having a first and second density" as required by claim 1.

Additionally, in levying an obviousness rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. See MPEP § 2143 (8th Ed., Rev. Feb. 2003). "Both the suggestion and the reasonable expectation of success must be

founded in the prior art, not in the applicant's disclosure." *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner's burden in levying an obviousness rejection is discussed above. The Federal Circuit recently emphasized the importance of evidencing the requisite motivation to combine references when rejecting claims based upon obviousness. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In the present case, the Examiner has failed to make the requisite showing, as articulated in *Lee* and its predecessors, of a motivation to combine the Harnett, Madley, Kirk-Othmer and Kuroda. For example, Harnett specifically teaches a method that does not use mechanical pressure to form a carbon body, while Madley specifically uses mechanical pressure in forming briquettes. Given the opposite teachings of Harnett and Madley, one skilled in the art would not be motivated to combine Harnett and Madley. Accordingly, the Examiner as failed to establish a *prima facie* case of obviousness and Applicants respectfully request the rejection under § 103 be withdrawn.

For at least the foregoing reasons, Applicants respectfully submit that claim 15 and claims 16-34, which depend from claim 15 are allowable.

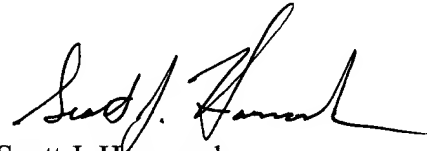
CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



Scott J. Hawranek
Reg. No. 52,411



Philip D. Lane, Ph.D.
Reg. No. 41,140

Date: September 25, 2003

McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, VA 22102-4215
Tel: 703-712-5069
Fax: 703-712-5296

\\COM\203243.2